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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/705,481

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Sonya S. Johnson

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EXAMINER

ROBERTS, LEZAH

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

12/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/705,481	Applicant(s) JOHNSON ET AL.	
	Examiner LEZAH W. ROBERTS	Art Unit 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,7-11,14,18-21 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,7-11,14,18-20 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the Amendment filed August 13, 2008. All previous rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims

Claim Rejections - 35 USC § 103 – Obviousness (Previous Rejection)

Claims 1, 4, 7-11, 14, 18-20 and 27-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kumamoto et al. (US 2002/0119231) in view of Sturtz (US Plant 8,645). The rejection is maintained.

Applicant's Arguments

Applicant argues there is no reason why the skilled artisan would combine Kumamoto et al. and Sturtz. Sturtz is entirely directed toward providing compositions that do not cause epithelial irritation by including large amounts of menthol. As such, Sturtz teaches away from the combination with Kumamoto and from the present claims. Kumamoto teaches menthol and does not disparage the use of menthol because of any possible irritation that it may cause. The fact that Kumamoto even teaches that menthol can be used as a cooling agent would lead the skilled artisan away from a combination with Sturtz. Because Sturtz teaches a low-menthol mint plant for producing an oil

Art Unit: 1612

wherein “menthol is substantially absent form the oil” of the plant, Sturtz also teaches away form the present claims. The Patent Office has improperly applied hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. The fact that the prior art may be modified in the manner suggested the Patent Office does not make the modification obvious. Applicant further argues even if the references are combinable they do not disclose or suggest all of the elements of the presently amended independent claims. There is also no disclosure of how much erospicata oil is used in a consumable product. Kumamoto also does not disclose or suggest a composition comprising menthol and a non-menthol cooling agent. This argument is not persuasive.

Examiner's Response

One of the reasons one of skill in the art would combine the two references is to be able to use menthol as a cooling agent while still having a strong peppermint flavor without using a lot of peppermint oil, which adds additional menthol. When using the menthol and erospicata oil together as separate components, one may optimize the amount of each component to achieve the desired effect. Sturtz does not teach not using menthol at all, it teaches an alternative to avoid too much menthol being used. Further, although menthol is not in an abundant amount in erospicata oil, it is present therefore when using erospicata oil in the compositions of Kumamoto, menthol will also be present. Therefore Sturtz does not teach away from using menthol it teaches

Art Unit: 1612

alternatives so that a large amount of menthol does not have to be used and a strong peppermint taste may be obtained. One of skill in the art would recognize, when menthol is required, for instance as a medicinal agent, and peppermint is preferred as a flavorant, that erospicata oil would be beneficial to give a strong peppermint flavor without using too much menthol and still achieving the medicinal benefit. Peppermint oil also has other components that make it undesirable such as piperitone, which provides a bitter taste (Sturtz, col. 3, lines 1-4). One of skill in the art would be motivated to use erospicata oil in place of peppermint to obtain the peppermint taste while avoiding a bitter taste and being able to add menthol in the desired amount to achieve its benefit without adding too much menthol, which leads to irritation.

Therefore, Sturtz provides several reasons why one would use erospicata oil, the first, to avoid too much menthol when this is desired and second, to avoid the bitter taste due to piperitone when this is desired. Kumamoto does teach using menthol, but it does not teach it as the preferred cooling agent. One of skill in the art would be aware of the properties of menthol, as disclosed by Sturtz, and would recognize when menthol is and is not suitable for use. In regards to hindsight reasoning, the primary reference lists menthol as a possible cooling agent but also discloses other cooling agents which are preferred. One of skill in the art would consider this and would reasonably choose one of the preferred cooling agents when menthol is not suitable. The menthol would be introduced, as required by the instant claims, when erospicata is added because erospicata comprises 1% menthol, encompassing the instant claims. In regards to the amounts, normally, changes in result effective variables are not patentable where the

Art Unit: 1612

difference involved is one of degree, not of kind; experimentation to find workable conditions generally involves the application of no more than routine skill in the art. See MPEP 2144.05 II. It would have been obvious to adjust the amount of erospicata oil in the flavor composition motivated by the desire to achieve optimum flavor in the oral composition. Therefore the combined references taken as a whole, teach the limitation of the instant claims.

Claims 1, 4, 7-11, 14, 18-20 and 27-33 are rejected.

Claims 21 and 24-26 are withdrawn.

No claims allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1612

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEZAH W. ROBERTS whose telephone number is (571)272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lezah W Roberts/
Examiner, Art Unit 1612

Application/Control Number: 10/705,481
Art Unit: 1612

Page 7

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612